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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/010,102

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Scan J. Egan

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EXAMINER

GREENE, DANIEL LAWSON

ART UNIT

PAPER NUMBER

3694

MAIL DATE

DELIVERY MODE

09/16/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/010,102	Applicant(s) EGAN, SEAN J.	
	Examiner DANIEL L. GREENE JR.	Art Unit 3694	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-11 and 23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-11, 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. Applicant's communication received 6/5/2009 has been considered and entered. Claims 7-11 and 23 are pending, with claims 1-6 and 12-22 being just recently cancelled and new claim 23 being added in said communication. Applicant amended the limitations of claims 7, 8 and 9 and amended the dependencies of claims 8-11. Accordingly an action on the merits of claims 7-11 and 23 follows.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/5/2009 has been entered.

Response to Amendment

3. Applicant's amendments to the claims have overcome the objections and rejections set forth in sections 3, 4, 7-9 and 11-14 of the previous Office action mailed 4/16/2009.

Accordingly said objections and rejections are hereby withdrawn.

Response to Arguments

4. Applicant's arguments set forth on pages 6-10 of the communication filed 6/5/2009 have been fully considered but they are not persuasive as expounded upon below.

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5. Applicant's arguments set forth on pages 6-9 against the 35 USC 102 rejection set forth in section 16 of the previous Office action have been considered but they are NOT persuasive.

a. In response to applicant's allegation on page 7 that Graff does not disclose operating a computer to identify financial futures corresponding to a sector, applicant is reminded that Graff clearly states in, for example, the abstract, paragraphs [0032], [0045], etc. that the invention is applicable to other industries that real estate including financial futures.

b. In response to applicant's allegation that Graff does not disclose an adjustment factor specific to the fund, applicant is directed to, for example, Figure 4A wherein item 98 includes "extra costs due to split purchase" which is synonymous with applicants claimed "adjustment factor".

c. In response to applicant's allegation that Graff does not disclose selecting a sector and performing calculations pertaining to a specific "sector, it must be appreciated that each of the properties disclosed are connote and are considered as "sectors".

6. Applicant's arguments set forth on pages 9-10 against the 35 USC 103 rejection set forth in section 17 of the previous Office action have been considered but they are NOT persuasive.

a. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include

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knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). On pages 11-16 of the previous Office action, the Examiner provided definitions of terms that are considered old and well known in the financial industry. Applicant has not refuted the allegations of the Official Notice or the terms defined within said previous Office action.

b. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Without acquiescing to applicant's allegations of what APA does or does not disclose, attention is directed towards the definitions set forth in said previous Office action including expected value (page 13), expected rate of return (page 14), of accounting return (page 15), rate of return (page 17). The calculation of the expected rate of return clearly discloses calculating an expected range of returns. Accounting return calculates anticipated return over a time period. Rate of return teaches that a common stock rate of return is dependent on the dividend PLUS capital appreciation, wherein it is understood that the term "capital appreciation" connotes the claimed "adjustment factor".

7. Applicant's arguments set forth on page 10 against the 35 USC 101 rejection set forth in section 20 of the previous Office action have been considered but they are NOT persuasive. The side by side comparison of instant claim 7 with Claim 8 of application 12/078,395 set forth immediately below, reveals the following similarities:

Claim 7 of instant application	Claim 8 of 12/078,395
A method for predicting expected returns of a fund, comprising the steps of:	8. A method for predicting expected returns of a fund, comprising the steps of:
operating a computer to select a sector corresponding to the fund,	This limitation is considered inherent as subsequent steps require this information in order to perform the intended calculations.
operating the computer to identify financial futures corresponding to the sector,	This limitation is considered inherent as subsequent steps require this information in order to perform the intended calculations.
operating the computer to calculate an expected return over a time period for the sector based on the financial futures corresponding to the sector,	calculating an expected return over a time period for a sector corresponding to the fund based on financial futures corresponding to the sector;
operating the computer to calculate an expected range of future returns for the sector based on prices of options for the futures, and	calculating an expected range of returns for the sector based on prices of options for the futures; and
operating the computer to calculate an expected annual return for the fund based on the expected annualized return for the corresponding sector, the expected range of returns for the corresponding sector, and at least one adjustment factor specific to the fund.	calculating an expected annual return for the fund based on the expected annualized return for the corresponding sector, the expected range of returns for the corresponding sector and on information specific to the fund.

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

9. **Claims 7-11 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by US 2002/0046144 A1 to Graff for the reasons set forth in section 16 of the previous Office action mailed 4/16/2009.**

See the discussion of this topic in section 5 above.

Claim Rejections - 35 USC § 103

10. **Claims 7-11 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Admitted Prior Art (APA) in view of Official Notice for the reasons set forth in section 17 of the previous Office action mailed 4/16/2009, which in turn refers to the reasons set forth in section 9 of the previous office action mailed 6/9/2008.**

See the discussion of this topic in section 6 above.

Double Patenting

11. Claims 7-11 and 23 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 8-11 of copending Application No. 12/078,395.

This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

See the discussion set forth in section 7 above.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL L. GREENE JR. whose telephone number is (571)272-6876. The examiner can normally be reached on Mon-Thur.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. L. G./

Examiner, Art Unit 3694

2009-09-14

/James P Trammell/

Supervisory Patent Examiner, Art Unit 3694